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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
2002P03695WOUS

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/528,730	March 22, 2005

First Named Inventor
Oliver Brasse

Art Unit	Examiner
2614	MD S. Elahee

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____.
- ☑ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 55,179

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January 7, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

A. Claims 13-25 and 27-29 Are Not Anticipated By The Cited Art

Claims 12 as here amended defines a method that includes storing digital sound sequences on the working memory of a PBX, connecting at least one telecommunication terminal to the PBX, holding a connection request from at least one telecommunication terminal requesting a connection to another communication terminal, a CPU of the PBX accessing the working memory of the CPU, and the switch device of the PBX transmitting the digital sound sequences from the working memory to at least one telecommunication terminal while the connection request of the at least one telecommunication terminal is being held. Claims 13-25 and 27-29 depend directly or indirectly from claim 12 and, therefore, also contain the limitations of claim 12.

McCormack et al. disclose a PBX that includes a MOH server built into the PBX. (Figure 5, ¶78). However, McCormack et al. do not teach, show or otherwise disclose a PBX that includes digital sound sequences stored on working memory of the PBX's CPU or a switch device configured to transmit the digital sound sequences stored on the working memory of a PBX's CPU while the connection request of one or more communication terminals is being held.

To establish anticipation, a prior art reference "must not only disclose all elements of the claim within the four corners of the document, but also disclose those elements arranged as in the claim." *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 88 U.S.P.Q.2d 1751, 1758, 2008 WL 4614511, *8 (Fed. Cir. 2008). McCormack et al. do not show or suggest any arrangement of a PBX that includes a CPU of the PBX accessing the working memory of the CPU for transmission of sound signals to a communication terminal while that communication terminal is being held. Nor does McCormack et al. show or teach a switch device of the PBX transmitting the digital sound sequences from the working memory of a PBX's CPU to any telecommunication terminals while the connection request of those one or more telecommunication terminals are being held.

McCormack et al. only show or teach a music on hold server being included in a PBX (Fig. 5, ¶ 78). The MOH server would necessarily include its own controllers and memory. (¶ 78). The teaching provided by McCormack et al. is that the MOH server and a PBX server may be housed within the same housing instead of being located in separate locations or in separate housings. There is no disclosure nor suggestion of any component, arrangement of components or functions provided by components of the PBX that are configured to provide

MOH services as required by claims 12-25 and 27-39. To the contrary, McCormack et al. teach that such functionality is provided by the components of the built-in MOH. (¶ 78).

B. Claim 29 Is Not Anticipated By The Cited Art

Claim 29 defines a method for handling digitally stored sound sequences in a telecommunications system that must include digitally storing sound sequences in the working memory of a PBX's CPU, connecting telecommunications terminals to a PBX via a switching apparatus, holding a connection request of at least one telecommunications terminal, and outputting sound sequences from the working memory via the switching apparatus to the at least one telecommunications terminal that has the connection request being held. The CPU must access at least a portion of the working memory for the switching apparatus of the PBX to output the digitally stored sound sequences stored in the working memory of the PBX's CPU.

As discussed above with reference to claim 12, McCormack et al. do not teach or suggest a CPU of a PBX that accesses at least a portion of its working memory for a PBX to output or transmit digitally stored sound sequences. Therefore, claim 29 is not anticipated by McCormack et al.

C. Claims 30-33 Are Not Anticipated By The Cited Art

Claim 30 requires a PBX to include a CPU having a working memory, and a switching device configured to connect to at least one communication terminal. The CPU is connected to the switching device. The working memory has digital sound sequences. The CPU is configured to access the working memory such that the switching device transmits the digital sound sequences from the working memory to the at least one communication terminal while a request for a connection to another communication terminal is being held by the PBX. Claims 31-33 depend directly or indirectly from claim 30 and, therefore, also contain the limitations of claim 30.

As discussed above with reference to claim 12 and the claims that depend from claim 12, McCormack et al. do not teach or otherwise disclose a PBX that includes a CPU that has working memory with digital sound sequences stored on the working memory. Indeed, McCormack et al. require a PBX to include a separate, built-in MOH server. (¶ 78). Such a built-in MOH server requires the MOH server to include its own processors, memory, and other components. The MOH server does not share a CPU that processes the PBX functions nor a

working memory of a CPU that has sound sequences that are to be transmitted to at least one terminal that has its connection request being held by the PBX as required by the PBX of claims 30-33.

D. The Cited Art Does Not Render Pending Claims 1-25 And 27-33 Obvious

The combination of McCormack et al. and Moran do not teach or suggest the limitations of the pending claims 1-25 and 27-33. All of the claims require sound sequences to be stored on working memory of a PBX's CPU. Neither McCormack et al. nor Moran teach or suggest a PBX that includes a CPU that has working memory with sound sequences stored in the working memory. Therefore, the combination of these references also does not teach or suggest such a limitation.

1. The Cited Art Does Not Teach Or Suggest A TSA As Required By Claims 14-17, And 31-32

The Examiner correctly found that McCormack et al. do not teach or suggest a TSA nor a FIFO. (Office Action, at 5-6). The Examiner has contended that Moran teaches or suggests a TSA or a FIFO. However, Moran does not teach or suggest a TSA or a FIFO as required by the pending claims.

Claim 14 depends from claim 12 and requires a PBX to include a TSA that is connected to a CPU. The TSA is configured to assign the digital sound sequences to programmed timeslots. Claim 16 depends from claim 14.

Claim 15 depends from claim 12 and requires a PBX to include a TSA that is configured to access the working memory and assign digital sound sequences to programmed time slots. Claim 17 depends from 15.

Claim 31 requires a PBX to include a TSA that has a FIFO shift register configured to support a packet-by-packet data transfer of digital sound sequences transmitted from the working memory of the PBX's CPU. Claim 32 requires a TSA to access working memory of a CPU to be configured to assign the digital sound sequences to programmed timeslots.

Moran does not disclose a PBX that includes a TSA configured to assign digital sound sequences to programmed time slots nor a TSA that is configured to access a working memory and assign sound sequences to programmed time slots. Moran discloses a multimode time division switching system that is configured to transmit sound to a terminal when the terminal is

found to have a phone off its hook or if a digit is dialed by a subscriber. (Col. 5, lines 31-67 and Col. 6, lines 1-29). Moran does not teach or suggest a TSA that is connected to the CPU of a PBX such that the TSA can access the working memory of a CPU to assign programmed time slots to sound sequences that are outputted while a connection request is being held by the PBX.

Further, as discussed above, McCormack et al. do not teach or suggest a PBX that has a CPU with working memory that is configured to transmit the sound sequences in its working memory to a terminal that has its connection request being held. The combination of Moran and McCormack et al. do not teach each and every limitation of claims 14-17 or 31-32. These claims are allowable over the cited art.

2. The Cited Art Does Not Disclose A TSA As Required By Claim 23 And Claim 33

Claim 23 requires a CPU to request a microcontroller to set a start address of a digital sound sequence in the FIFO shift register of the TSA and to set a destination address in the working memory for recording sound sequences. Claim 33 requires a TSA to include a microcontroller configured to set a start address in the FIFO shift register of a TSA for recording sound sequences.

The Examiner correctly found that Moran did not teach or suggest recording of sound sequences. (Office Action, at 8). However, the Examiner found McCormack et al. taught recording of sound sequences at paragraphs 59, 61-62, 69-71, 73, 76 and 78. (Office Action, at 8). To the contrary, McCormack et al. only teach or suggest transmitting sound sequences to a terminal that is having it connection request held. There is no teaching or suggestion or recording sound sequences to the working memory of a PBX. Nor is there any suggestion of using a TSA and a microcontroller of a PBX to record sound sequences.

Moran does not teach or suggest any recording of any sound sequences nor the setting of a start address in a FIFO shift register by a microcontroller of a PBX to record sound sequences. McCormack et al. also do not teach or suggest such requirements. Therefore, the combination of Moran and McCormack et al. do not teach or suggest these limitations. Claims 23 and 33 are allowable over the cited art.

E. <u>McCormack et al. Teach Away From Limitations Of The Claims</u>

McCormack et al. teach away from a PBX that includes a CPU that has working memory that has sound sequences stored in the working memory. To the contrary, McCormack et al.

require a PBX to include a separate MOH server built into the PBX, which requires a separate MOH processor and memory for the MOH server. (¶ 78). Requiring separate CPUs and separate working memory for the PBX and MOH services is contrary to the requirements of the pending claims.

Indeed, McCormack et al. teach the opposite of the pending claims. The claims require a PBX to be configured to have a CPU and working memory that are configured to provide MOH services while also providing PBX services. McCormack et al. require separate servers with separate CPUs and working memory to provide such services.

F. The Elimination Of The Built In MOH Server Of McCormack et al. Shows The Pending Claims Are Not Rendered Obvious

An invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

McCormack et al. require a PBX to include a separate MOH server built into a PBX to provide MOH services. (¶78). As noted in the specification of the present application, a separate MOH server is not required by the PBX of the pending claims, such as an IP-PBX or other PBX. Indeed, the separate hardware and other components of a MOH server is eliminated as necessary components by the configuration of the CPU and working memory of the PBX as required in the pending claims. The elimination of the features of the MOH server with the retention of their function is an indicia of nonobviousness and shows that McCormack et al. do not render the pending claims obvious.